Serial No. 10,028,718   Docket No. CITI0243

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of

Grigor MARKARIAN, et al.   Group Art Unit: 3629

Serial No.: 10/028,718   Examiner: BORISSOV, Igor

Filed: December 28, 2001

For: **METHOD AND SYSTEM FOR CONDUCTING COMMERCE OVER A
       WIRELESS COMMUNICATION NETWORK**

BY FACSIMILE - 571-273-8300

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop <u>Appeal</u>
Randolph Building
401 Dulany Street
Alexandria, VA 22314

SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

This is an Appeal Brief under 37 C.F.R. § 41.37 in connection with the final Office Action mailed December 22, 2004, the Advisory Action mailed on June 15, 2005 and the notice of non-compliant appeal brief mailed April 13, 2006. Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

(1)   Real Party In Interest

The real parties in interest are Citibank, N.A., having an office at 399 Park Avenue, New York, New York 10043 and Citicorp Development Center, Inc. having an office at 12731 W. JEFFERSON BOULEVARD LOS ANGELES, CALIFORNIA 90066.

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(2)   Related Appeals And Interferences

Appellants are unaware of any related appeals and interferences.

(3)   Status Of Claims

Claims 12 and 14-18 are pending on this application. Claims 1-11 and 13 have been cancelled in a previous action. Claims 12 and 14-18 stand under final rejection, from which rejection this appeal is taken.

(4)   Status of Amendments

The claims have not been amended after the final Office Action dated December 22, 2004.

(5)   Summary Of The Claimed Subject Matter

This summary of claimed subject matter is a concise explanation of the subject matter defined in independent claims 12 and 18. This is merely meant to be a summary and is in no way intended to limit the pending claims.

The present invention provides a mobile system for facilitating mobile commerce among multiple parties, including consumers, merchants and financial institutions. (Pg. 6, ll. 5-6). The mobile system performs at least one, and preferably all three of the following three functions: 1) protocol conversions; 2) customer information reposing, and 3) payment authorization system interfacing. (Pg. 6, ll. 7-8). The mobile system achieves these functions using at least one of the following components: a state manager; parsing agents for parsing e.g., XML and HTML; translation agents for translating to and from e.g., WAP, CHTML and HDML; communication agents for communicating between e.g., HTTP (HyperText Transfer Protocol) and HTTPS (Secure HyperText Transfer Protocol); server and database configurations; and settlement systems. (Pg. 6, ll. 9-13; Figure 1, reference nos. 10, 15, 20, 25 and 30).

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The mobile system is capable of presenting a transmission from a mobile device to participating Web servers as a standard Web client, thus performing a gateway/ protocol conversion function between a mobile device and a merchant site or sites. (Pg. 6, ll. 16-18; Figure 1, reference no. 40). To accomplish this, the mobile system allows users of mobile devices to communicate through the web with merchant site applications running on web servers using, for example, HTTP or HTTPS protocols. (Pg. 6, ll. 18-21). The mobile system dynamically performs the required translation between the merchant site webpages encoded in, for example, HTML, CHTML, XHTML or XML to WML, CHTML or HDML for the mobile device. (Pg. 6, l. 21- pg. 7, l. 2).

In order to perform merchant site format translation to mobile device format, the mobile system insures that all communication between the merchant site and the mobile device occurs through the mobile system architecture. (Pg. 7, ll. 8-10). Using the mobile system's link/URL management feature, this is insured by dynamically converting all Hyperlink (Href) information on the page published by the merchant site to the URL (universal resource locator) of the mobile system (e.g., URL of the company offering the services of the mobile system). (Pg. 7, ll. 10-13). The mobile system saves the original, unconverted URLs within a relational database 35. (Figure 1). In this manner, all user interaction from the mobile device is intercepted and interpreted by the mobile system prior to being forwarded to the merchant site. (Pg. 7, ll. 14-16).

Specifically, each means element of the independent claim 18 finds sufficient support in the specification as exemplified in the following summary. For example, Figure 2, and the corresponding description, illustrates the basic communications between a customer and a merchant as claimed in claim 18. Specifically, each element of the claim are supported as follows: "means for transmitting in a first language a request message for merchant website

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information from a mobile device" (p. 11, ll. 4-8); "means for receiving the request message in the first language at a platform and identifying the first language" (p. 11, ll. 8-10); "means for translating the request message at the platform from the first language to a second language that is recognizable by a merchant website" (p. 11, l. 10- p. 12, ll. 1-10); "means for communicating the translated request message in the second language from the platform to the merchant website (p. 12, ll. 11-13); "means for receiving at the platform the requested merchant website information from the merchant website in the second language" (p. 12, ll. 13-14). "means for recognizing the second language at the platform" (p. 12, ll. 14-16); "means for parsing the requested merchant website information in the second language into translatable pieces" (p. 12, ll. 14-19); "means for translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language" (p. 12, ll. 17-21); "means for transmitting the reply message to the mobile device" (p. 13, ll. 1-3).

Additionally, Figures 10, 11, and 12, as well as the corresponding descriptions, exemplify embodiments of the present invention specifically directed to the process of authorizing purchases. The claimed elements discussing purchase requests are exemplary configurations that are incorporated into previously described aspects of the claim. The elements of claim 18 addressing purchase requests are supported as follows: "means for transmitting a purchase request in response to the reply message in a first language to the platform" (p. 11, ll. 4-8); "means for receiving the purchase request in the first language at a platform and identifying the first language (p. 11, ll. 8-10); "means for translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website" (p. 11, l. 10- p. 12, ll. 1-10); "means for

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communicating the translated purchase request in the second language from the platform to the merchant website" (p. 12, ll. 11-13); "means for receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request" (p. 12, ll. 13-14; p. 25, ll. 1-7); "means for forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response" (p. 25, ll. 1-3); "means for receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system" (p. 25, ll. 4-7); "means for parsing the purchase request response in the second language into translatable pieces" (p. 12, ll. 14-19); "means for translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language" (p. 12, ll. 17-21); and "means for transmitting the purchase request response in the first language to the mobile device" (p. 13, ll. 1-3).

(6)   Ground or Rejection to be Reviewed on Appeal: Whether the Office's rejection of claims 12 and 14-18 under 35 U.S.C. § 103(a) as being unpatentable over Eerola (6,678,518) in view of Tompkins (2001/0056401) is proper.

(7)   Argument

For reference, independent claim 12 includes the following limitations:

> 12. (Previously Amended)   A method for conducting mobile commerce comprising:
>   transmitting in a first language a request message for merchant website information from a mobile device;
>   receiving the request message in the first language at a platform and identifying the first language;

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translating the request message at the platform from the first language to a second language that is recognizable by a merchant website;

communicating the translated request message in the second language from the platform to the merchant website;

receiving at the platform the requested merchant website information from the merchant website in the second language;

recognizing the second language at the platform;

parsing the requested merchant website information in the second language into translatable pieces;

translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language; and

transmitting the reply message to the mobile device;

transmitting a purchase request in response to the reply message in a first language to the platform;

receiving the purchase request in the first language at a platform and identifying the first language;

translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website;

communicating the translated purchase request in the second language from the platform to the merchant website;

receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request;

forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response;

receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system;

parsing the purchase request response in the second language into translatable pieces;

translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language; and

transmitting the purchase request response in the first language to the mobile device.

Similarly, independent claim 18 includes means for performing the steps of claim 12. (See

Appendix of Claims). The Office admits that the combination of limitations highlighted above

is not taught or suggested by Eerola, stating specifically (emphasis in original):

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Eerola does not specifically teach: *sending a purchase request to a merchant website; sending a purchase request response, including payment authorization reques', from the merchant website to a payment authorization system; and transmitting said purchase request response to the mobile device.*

(Final Office Action, Page 3). The Office cites a secondary reference, Tompkins, for this teaching. Tompkins is disqualified as prior art pursuant to 35 U.S.C. § 103(c), which states, in part:

> (c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application and Tompkins (2001/0056401) were, at the time the invention of the present application was made, owned by Citicorp Development Center, Inc. (hereafter "CDC") 12731 W. JEFFERSON BOULEVARD LOS ANGELES, CALIFORNIA 90066. Mr. Tompkins assigned his interest in the 2001/0056401 application to CDC on July 24, 2001 and the assignment was recorded at reel/frame 012015/0411. Similarly, the provisional patent application to which Tompkins (2001/0056401) claims priority was assigned by Mr. Tompkins to CDC and the assignment recorded at reel/frame 011773/0313. The present application was assigned to CDC on April 2 or 3, 2002 by all listed inventors and the assignment was recorded at reel/frame 012772/0593. Similarly, the provisional patent application to which the present application claims priority was assigned to CDC by all listed inventions and the assignment was recorded at reel/frame 011959/0465.

Accordingly, the Office's *prima facie* case of unpatentability with the combination of Eerola and Tompkins as Tompkins is hereby rebutted as Tompkins does not qualify as prior

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art. Further, even if Tompkins does qualify as prior art, Tompkins does not teach or suggest

the limitations missing from Eerola. The Office points specifically to paragraphs [0028] and

[0065] of Tompkins as teaching the combination of missing limitations. These paragraphs

relied upon by the Office are set forth below:

[0028] Another aspect of the present invention is the integration of a cellular telephone and related telecommunication system with a home banking system. To achieve the stated objects, advantages and novel features of the present invention, an embodiment of the invention provides a method and system of performing a transaction for a user at a remote terminal, which makes use, for example, of a server, such as a financial institution-controlled banking application server, and a wireless communication link between the server and the remote terminal. The remote terminal includes, for example, a wireless communication device, such as a wireless cell phone device, coupled to, for example, an HTML renderer, which in turn is coupled, for example, to a television set in the user's home. The HTML renderer can be housed in a set top box (STB), or the HTML renderer and the wireless communication device can be housed together in a stand-alone STB, or they can be incorporated in the television set or other display device. Further, the wireless communication device can be a standard cell phone. The remote terminal also includes, for example, an input device for the user linked to the wireless communication device, such as a keyboard, an infrared (IR)-driven keyboard, a mouse, an IR driven mouse, or the number pad of a standard cell phone.

[0065] FIG. 4 depicts data flow in an embodiment of the present invention during a credit card authorization transaction in an e-commerce setting. Utilizing TV, 2 and set top system 3, a user interacts, through processor 4 and the internet 20, with merchant and merchant server 30, through communication links 101, 103 and 105. User selects a good and requests the merchant charge the user's credit card. Merchant server 30 communicates through internet 20, and communication links 107 and 109, with financial services institution server 6 that acts as the processor for the transaction through credit and debit processing system 10. The credit and debit processing system routes the transaction details, through communication link 111, to the sponsoring credit card association server 40, utilizing a financial services industry network. Association server 40 transmits an authorization request, through communication link 113, to an issuing bank server 50. The issuing bank server authorizes or denies the transaction and communicates the results, through communication link 115 back to association server 40. The information is next passed, through communication link 117, to credit and debiting processing system 10 of server 6. Merchant 30 is notified through communication links 119 and 121, and then the user is notified that the

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transaction has been approved or denied through the processor utilizing communication links 123, 125 and 127. Alternatively, in an embodiment of the present invention, processor the transaction approval/denial details are communication directly to processor 4 by financial services institution server 6, and communication link 129. Details relating to the type of information transmitted and the approval or denial process are set forth in the applications referenced above. The reference to communication links in the foregoing description is provided to illustrate the flow of data between servers. A single physical, or wireless, 2-way communication link may exist among the various servers. Further, as will be understood by those of ordinary skill in the art, the issuing bank may be the same or different from the financial institution providing the processing services.

Initially, the undersigned representative notes that these two paragraphs are unrelated in that they describe separate embodiments. Paragraph [0028] describes the integration of a cellular telecommunications system with a home banking system. Paragraph [0028] does not describe a method and system for transmitting, translating, parsing and receiving purchase request and reply to purchase request information between a mobile device and a merchant website. Paragraph [0065] describes an e-commerce flow as between a TV set-top box and a merchant site for purchase requests and payment authorizations. Neither of the paragraphs cited teach or suggest the combination of limitations from claims 12 or 18 highlighted above.

Accordingly, the undersigned representative respectfully requests that the rejections of claims 12 and 14-18 under 35 U.S.C. § 103(a) be withdrawn. Further, dependent claims 14-17 are also allowable as they contain the limitations of claim 12 on which they depend.

(8)   **Claims Appendix**

See Appendix of Claims below.

(9)   **Evidence Appendix**

None.

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(10)   Related Proceedings Appendix

None.

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CONCLUSION

For the reasons set forth herein, the undersigned submits that the claims are allowable

over the cited art and respectfully requests that the Board of Patent Appeals and Interferences

direct the Office to issue a notice of allowance to this effect.

Respectfully submitted,

Date: 4/10/0(i
KILPATRICK STOCKTON LLP
607 14th Stree , N.W., Suite 900
Washington, D.C. 20005

/Dawn-Marie Bey Reg. No. 44,442/
Dawn-Marie Bey
Registration No. 44,442

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Appendix of Claims

1. –11. (Cancelled).

12. (Previously Amended)   A method for conducting mobile commerce comprising:

transmitting in a first language a request message for merchant website information from a mobile device;

receiving the request message in the first language at a platform and identifying the first language;

translating the request message at the platform from the first language to a second language that is recognizable by a merchant website;

communicating the translated request message in the second language from the platform to the merchant website;

receiving at the platform the requested merchant website information from the merchant website in the second language;

recognizing the second language at the platform;

parsing the requested merchant website information in the second language into translatable pieces;

translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language; and

transmitting the reply message to the mobile device;

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transmitting a purchase request in response to the reply message in a first language to the platform;

receiving the purchase request in the first language at a platform and identifying the first language;

translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website;

communicating the translated purchase request in the second language from the platform to the merchant website;

receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request;

forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response;

receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system;

parsing the purchase request response in the second language into translatable pieces;

translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language; and

transmitting the purchase request response in the first language to the mobile device.

13. (Cancelled).

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14. (Originally Presented)   The mobile commerce system according to claim 12,

wherein the first language is a wireless language.

15. (Originally Presented)   The mobile commerce system according to claim 14,

wherein the wireless language is selected from the group consisting of wireless

markup language (WML), handheld device mark-up language (HDML), Imode, and

compact hypertext markup language (CHTML).

16. (Originally Presented)   The mobile commerce system according to claim 12,

wherein the second language is a web-based language.

17. (Originally Presented)   The mobile commerce system according to claim 16,

wherein the web-based language is selected from the group consisting of extensible

markup language (XML), compact hypertext markup language (CHTML), extensible

hypertext markup language (XHTML), and hypertext markup language (HTML).

18. (Previously Amended)   A system for conducting mobile commerce comprising:

    means for transmitting in a first language a request message for merchant

website information from a mobile device;

    means for receiving the request message in the first language at a platform

and identifying the first language;

    means for translating the request message at the platform from the first

language to a second language that is recognizable by a merchant website;

    means for communicating the translated request message in the second

language from the platform to the merchant website;

    means for receiving at the platform the requested merchant website

information from the merchant website in the second language;

means for recognizing the second language at the platform;

means for parsing the requested merchant website information in the second language into translatable pieces;

means for translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language; and

means for transmitting the reply message to the mobile device;

means for transmitting a purchase request in response to the reply message in a first language to the platform;

means for receiving the purchase request in the first language at a platform and identifying the first language;

means for translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website;

means for communicating the translated purchase request in the second language from the platform to the merchant website;

means for receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request;

means for forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response;

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means for receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system;

means for parsing the purchase request response in the second language into translatable pieces;

means for translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language; and

means for transmitting the purchase request response in the first language to the mobile device.

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